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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,640	02/14/2002	Peter Konrad	07508-033001	9652

7590 11/07/2003

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EXAMINER	
PASS, BARRY	

ART UNIT	PAPER NUMBER
3737	

DATE MAILED: 11/07/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/914,640	KONRAD ET AL.	
	Examiner	Art Unit	
	Barry Pass	3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 June 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Abstract

1. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

2. The abstract of the disclosure is objected to because it is not a concise statement of the technical disclosure of the patent and does not include that which is new in the art to which the invention pertains Correction is required. See MPEP § 608.01(b).

Specification

Page1 of the specification should be titled "Detailed Description" to conform to the amendment to the specification.

The underlined heading on page 1 is redundant and should be omitted.

Incorrect, frequent use of one-sentence paragraphs is used throughout. Proper English syntax should be used.

The physical appearance of quotation marks should conform to standard English practice (no inverted, subscripted marks).

Reference to "the various" drawings" in the "Description of Drawings" section of the amendment to the Specification is unclear as there is only one drawing.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 5-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Curiel US 4,563,727. Curiel discloses (see entire document) a flashlight powered by a solar cell, a rechargeable nickel-cadmium storage unit, and a light source.

The recitation of an "instrument for determining a position in a navigation system that assists in surgical operations" in the preamble to claim 5 is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951). Further, a statement of intended use in an apparatus claim, such as claims 5-16, does not distinguish over a prior art apparatus if the prior art structure is capable of performing the intended use as recited in the preamble. See, e.g., In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed.Cir. 1997).

In regard to claims 5-13 the flashlight of Curiel can be used to illuminate a surgical field and thereby assist navigation in surgical operations. Further, the communication of information between the surgical instrument, the flashlight used to assist in determining the position of the instrument, and an operator of the instrument, is wireless. The use of a buffer in solar charged battery operated power supplies is inherent.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 5-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bucholz US 5,891,034 in view of Bucholz US 6,490,467, further in view of Koeda et al. US 5,924,978, further in view of Curiel. Buchholz '034 teaches (abstract, Fig. 4A, column 10, lines 25-59) a navigation system for a surgical probe using infrared emitters connected to a power supply, and the probe wirelessly communicating with infrared detectors for determining position of the probe. Bucholz '034 does not teach an autonomous (applicant's untethered) probe with a self-contained power supply driven by a solar cell for recharging a storage unit (e.g., a rechargeable battery). Buchholz '467 teaches (Figs. 11, 11A, 13A-13I, columns 15-16) a surgical navigation system comprising an a localization frame having a plurality of light-emitting diodes, an

untethered battery-operated localization frame for ease of use, and an optical probe as an example of a localization frame. It would have been obvious to someone of ordinary skill in the art at the time of the invention that the navigation system for a surgical probe with infrared emitters as taught by Bucholz '034 can, for convenience and ease of use, use a battery supply for the emitters in lieu of cables as taught by Bucholz '467.

Buchholz '034 and Bucholz '467 do not teach a rechargeable battery. Koeda et al. (abstract, claim 5) teaches a portable endoscope with a rechargeable battery. It would have been obvious to someone of ordinary skill in the art at the time of the invention that the navigation system for a battery-operated surgical probe with infrared emitters as taught by Bucholz '034 and Bucholz '467 can, as is well-known in the art, use a rechargeable battery supply for the instrument as taught by Koeda et al. for convenience. Use of a buffer in a solar charged battery power supply is inherent to charge-storage devices and is well-known in the art.

Buchholz '034, Bucholz '467 and Koeda et al do not teach an untethered active instrument with a rechargeable battery supplied by a solar cell. Curiel teaches an untethered source of illumination that is solar powered to reduce reliance on an external source of electric power. Accordingly, it would have been obvious to someone of ordinary skill in the art at the time of the invention that the navigation system for a rechargeable, battery-operated surgical probe with infrared emitters as taught by Buchholz '034, Bucholz '467 and Koeda et al. can, to reduce reliance on an external source of electric power, use a solar cell to charge the rechargeable storage battery to power the sources of light in the instrument as taught by Curiel.

Response to Arguments

8. Applicant's arguments with respect to claim5-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry Pass whose telephone number is (703) 305-0726. The examiner can normally be reached on Monday-Friday, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Ruhl can be reached on (703) 308-2262. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0873.

Barry Pass
November 4, 2003

DENNIS W. RUHL
SUPERVISORY PATENT EXAMINER